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BRIEF FOR APPELLEE DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

01-1445
(Serial No. 08/419,229)

IN RE PHILIP R. THRIFT and CHARLES T. HEMPHILL

Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

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Representative claims:

1. A voice activated Hypermedia system using grammatical metadata, said system comprising:
 - a. a speech user agent;
 - b. a network browsing module; and
 - c. an information resource located on a computer network wherein said speech user agent facilitates voice activation of said network browsing module to access said information resource.

14. A voice activated Hypermedia system using grammatical metadata, said system comprising:
 - a. a speech user agent;
 - b. a browsing module;
 - c. an information resource; and
 - d. a means for producing a grammar from textual representation of links to said information resource.

A159-60.

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RULE 47.5 STATEMENT OF RELATED CASES

(a) No other appeal from the Board of Patent Appeals and Interferences in connection with the patent application on appeal has previously been before this or any other court.

(b) There is no known related case pending in this or any other court.

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Appeal from the United States Patent and Trademark Office,
Board of Patent Appeals and Interferences.

STATEMENT OF THE ISSUES

1. Whether substantial evidence supports the Board of Patent Appeals and Interferences' findings that a person skilled in the electronic speech art would have been motivated to combine Stefanopoulos' database browser with electronic speech input as taught by Schmandt, rendering claim 1 obvious under 35 U.S.C. § 103.

2. Similarly, whether substantial evidence supports the Board's additional findings that a skilled electronic speech artisan would have been motivated to add to Stefanopoulos' browser a grammar producer, as taught by Schmandt, rendering claim 14 obvious.

STATEMENT OF THE CASE

A. TI's Invention

In 1995, Texas Instruments Incorporated (hereafter "TI") filed the subject application concerning the use of speech to select particular information contained in an electronic database. A25, 36.¹ The application discusses, as background, the Internet and World Wide Web. A25-26. As generally known, the World Wide Web consists of numerous information sites, or databases, which have unique electronic addresses also called "hyperlinks." A26. Common software tools known as "browsers" are routinely used to locate various database sites on the Web. A26, lines 17-18. TI's written description also states that the electronic power of personal computers ("PCs") has increased to the point that PCs can readily support speech input. A27.

The application describes using speech to develop for the browser "a grammar and associates it with a URL [universal resource location]." A28. For example, speaking the phrase "how does the weather look today" could link to the URL www.washingtonpost.com/weather. A29. The specification also discusses the use of "Smart Pages" described as "a page that contains a reference to a

¹ The Joint Appendix is referred to as "A____" and TI's Brief is referred to as "Br. at ____".

grammar” with the capability “to interpret the result of recognition based on that grammar.” A31, lines 25-26; see also A32-33, 35. The remainder of the specification generally focuses on Internet URL examples. A34, 36.

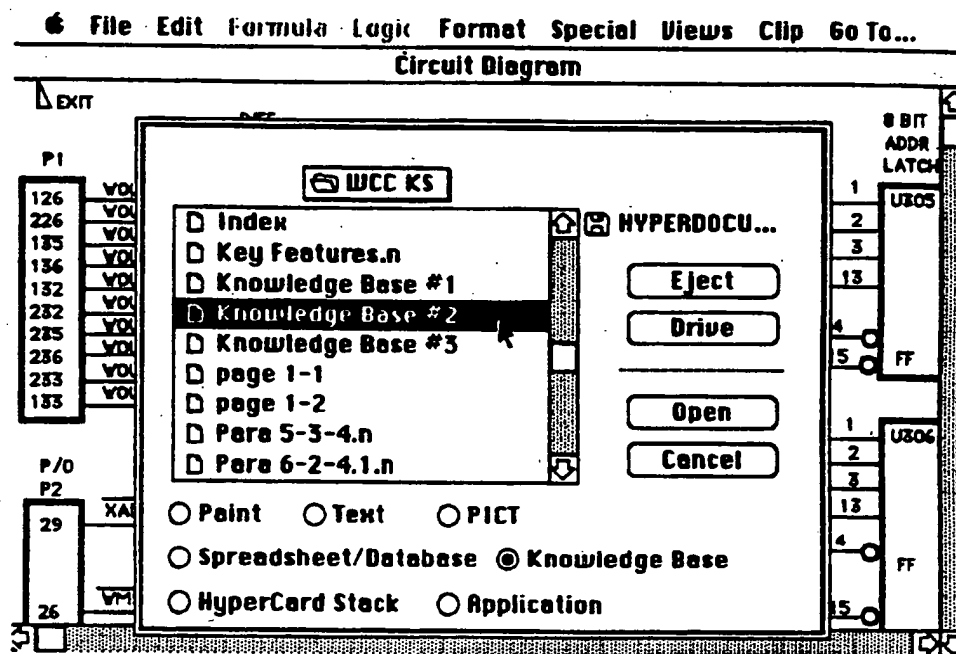
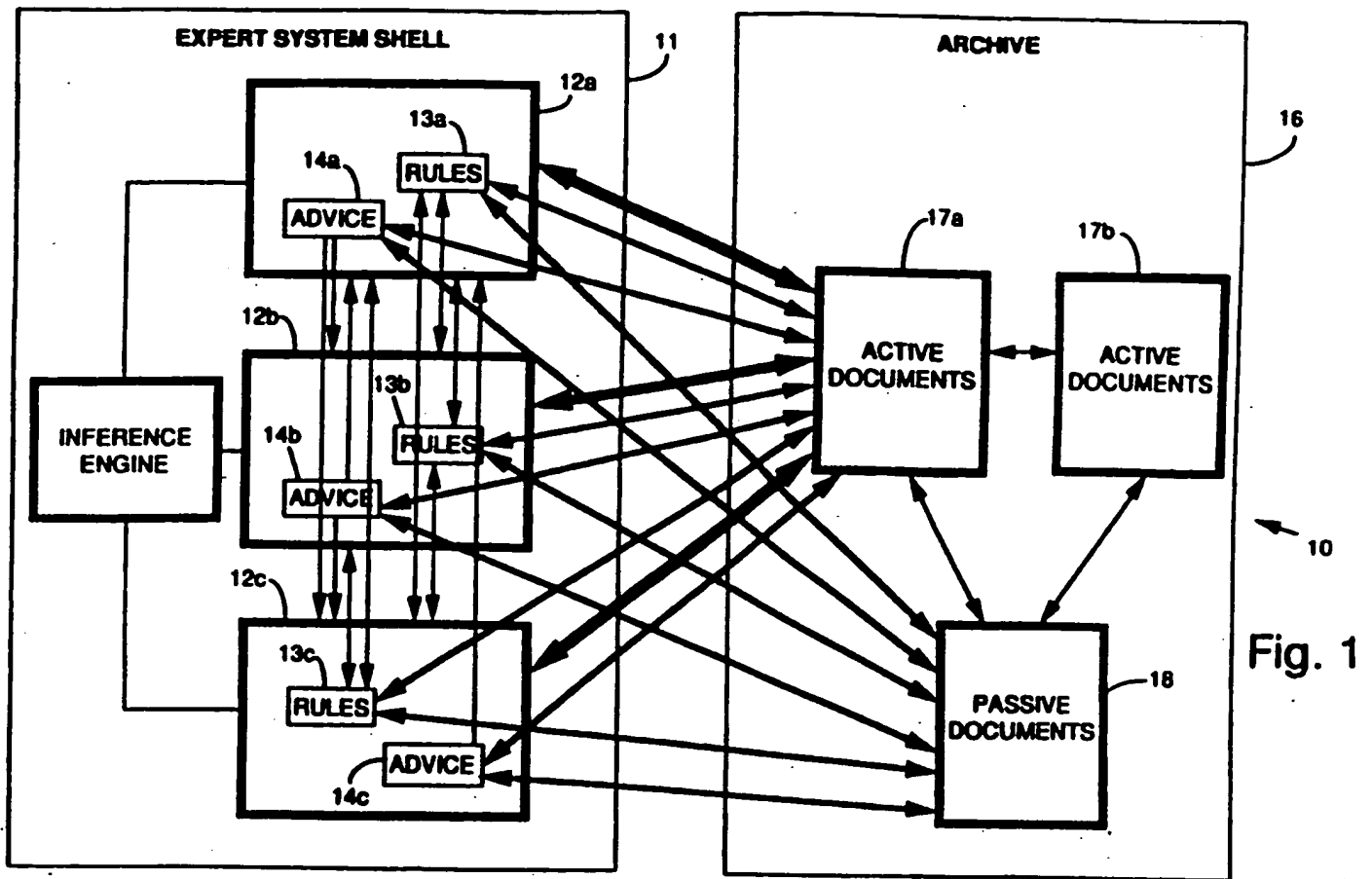
Independent claim 1 reads:

1. A voice activated Hypermedia system using grammatical metadata, said system comprising:
 - a. a speech user agent;
 - b. a network browsing module; and
 - c. an information resource located on a computer network wherein said speech user agent facilitates voice activation of said network browsing module to access said information resource.

A159. As claimed, this system includes an information database on a computer network, a browser for accessing the database, and a speech user agent to facilitate voice activation of the browser.

Independent claim 14 adds to claim 1 a capability for producing or building a language grammar for the speech input. Claim 14 reads:

14. A voice activated Hypermedia system using grammatical metadata, said system comprising:
 - a. a speech user agent;
 - b. a browsing module;



- c. an information resource; and
- d. a means for producing a grammar from textual representation of links to said information resource.

A160.

B. Prior Art

The Board affirmed (A11) the examiner's obviousness rejection in view of two references, Stefanopoulos and Schmandt.²

1. Stefanopoulos

Stefanopoulos is directed to a browser software system used to access and search several archived electronic documents. A126. Referring to Figure 1 (A127) (reproduced on the facing page), Stefanopoulos discloses PC hypermedia system 11 and archive 16 having "databases" 17 and 18. A148, col. 4, lines 13-15, 47-48, 55-59. Stefanopoulos' system also has a browser for accessing these databases. A132, Fig. 3g (reproduced opposite). As shown in Figure 3g, the PC's cursor/pointer is highlighting and selecting "Knowledge Base #2." Additionally, within knowledge base 2, other selections may be made. E.g., A133, Fig. 3i; A149, col. 5, lines 25-35. The selecting may be done by computer mouse, keyboard, or voice activation. A148, col. 4, lines 28-38.

² U.S. Patent 5,333,237 (A126-51), and 1990 IEEE article entitled "Augmenting a Window System with Speech Input" (A152-58), respectively.

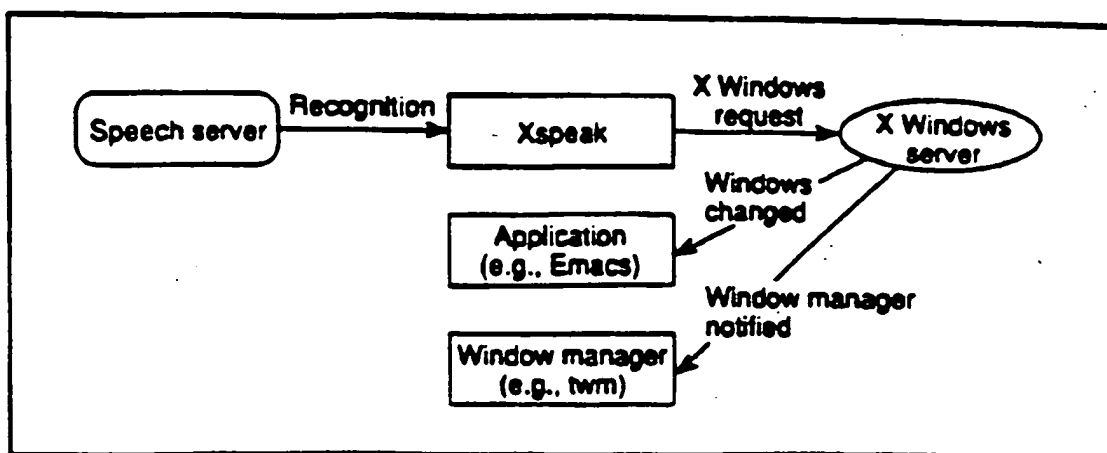


Figure 1. Interaction between processes in Xspeak.

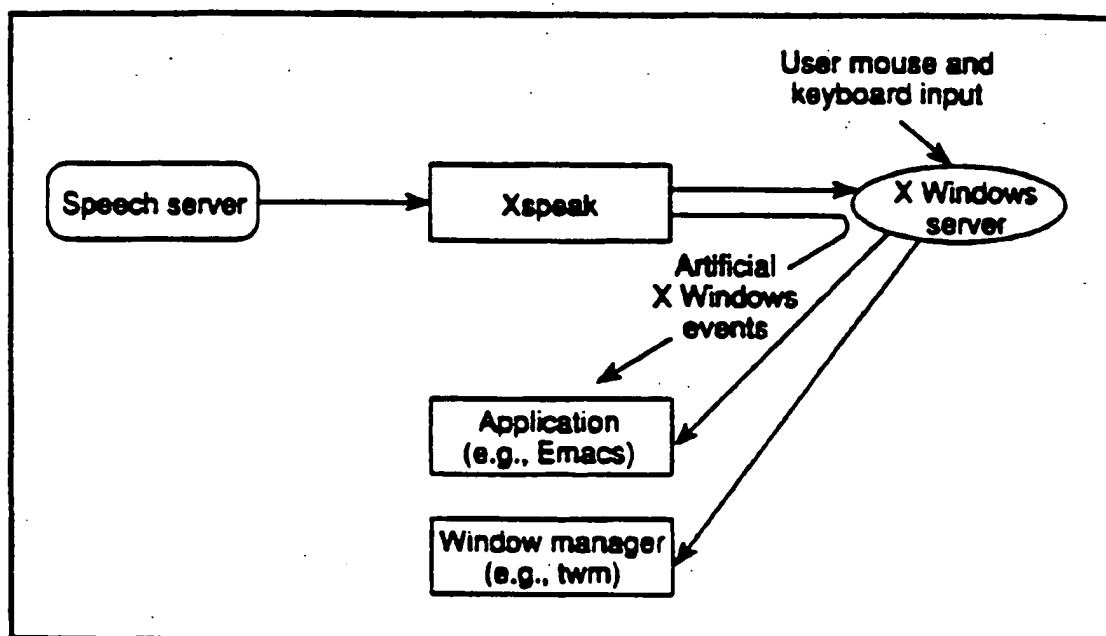


Figure 5. Interaction between processes in Xspeak II.

Stefanopoulos also discloses an instructional (or help) scheme for assisting the user. A138-39, Figs. 4h-4j; A149, col. 6, lines 55-68. As found by the examiner, Stefanopoulos discloses the processing of user action based on embedded intelligence and returning results to the user. A138, Fig. 4g; A149, col. 6, lines 52-54. Stefanopoulos also discloses the textual representation of hypertext links. A136, Figs. 4c, 4d; A144, Fig. 5b; A145, Fig. 5e; A149, col. 6, lines 32-42; A150, col. 7, lines 18-38.

2. Schmandt

Schmandt expressly describes the use of speech to manipulate a computer system or PC. A152. Referring to his Figures 1 and 5 (A154, 157) (reproduced on the facing page), Schmandt discloses a “speech server” interacting within a computer system having numerous connections and applications. Schmandt teaches the use of speech to browse and select within a computer environment. A152; 154, col. 2.

Schmandt discloses his “Xspeak” system which uses voice instead of a computer mouse to browse and select, and thereby saves a user time by avoiding or reducing the use of a mouse. A152, cols. 1-2; A153, col. 2, lines 1-8. Xspeak has “voice *templates*, [i.e.,] words trained and stored in the recognizer and constituting its vocabulary.” A154, col. 1 - col. 2 line 10 (emphasis in original).

Schmandt further discloses “Xspeak II” which uses a particular language or grammar “for translating spoken commands.” A152, col. 2; A156-57. Xspeak II includes “a user interface specification language,” described as “a rich tool for adding voice input to applications.” A152, col. 3.

C. United States Patent and Trademark Office (USPTO) Proceeding

In the context of this appeal, special focus on the content of TI’s arguments at each stage of the process is appropriate because TI made one set of arguments to the Board in its Appeal Brief, and a different set of arguments in requesting reconsideration and appealing to this Court.

1. The Examiner’s Rejection

In rejecting the claims based on obviousness, the examiner made numerous findings concerning Stefanopoulos and Schmandt with respect to TI’s claims. A51-55. For example, he expressly found that Stefanopoulos discloses a browsing module (A132, 149), information resource (A130, 131, 149), intelligence in a hypermedia source (A126), instructional module for communicating allowed actions (A138, 149, 150), processing user action based on embedded intelligence (A138, 149), returning a result of said actions to the user (A138, 149), and textual representation of links to an information source (A136, 144, 145, 149, 150). The examiner also found (A51-55) that Schmandt discloses an interface that uses speech

or voice to navigate in a window environment (A152, 154), speech recognition actions (A152), and tokenizing a title/dynamic addition of grammar (A155).

The examiner found that a skilled electronic speech artisan would have been motivated to use speech recognition with a browser in order to reduce manual, keyboard intervention and make the system more user friendly, thereby rendering claim 1 obvious. A51, lines 16-17. The examiner additionally found that the art of speech recognition has used particular grammars to optimize the applications employing them. A54, lines 17-20. Thus, the examiner found that a skilled artisan would have been motivated to employ such grammars in order to reduce manual, keyboard intervention and make the system more user friendly, thereby rendering claim 14 obvious. A55, lines 1-7. The examiner's findings regarding Stefanopoulos and Schmandt addressed all of TI's claims, and resulted in the § 103 rejection of all 19 claims.

2. TI's Appeal Brief to the Board

TI appealed to the Board. For claims 1, 11 and 14, TI argued in its Appeal Brief that Schmandt fails to disclose a "speech user agent" (A83-84), that neither Stefanopoulos nor Schmandt discloses a computer "network" (A84-86), and that the claims further cover the internet, HTML pages, and the World Wide Web (A86). Discussing only these claimed and unclaimed features, TI then argued that the

examiner improperly used hindsight to reject the claims. A86-87. For these claims, TI only argued and explained the speech user agent and network limitations. A83-87.

TI grouped claims 2-4 with claim 1. A87. TI then stated additional limitations for the remaining dependent claims, and generally asserted that the additional limitations were missing from the prior art. A87-92.

The examiner filed an answer. A93-102. TI did not file a reply brief to the Board.

3. Board Decision

For claim 1, the Board expressly agreed with/adopted the examiner's findings and determined that he established a prima facie case of obviousness. A12-13. In response to TI's arguments on appeal, the Board found that Schmandt and Stefanopoulos disclose "a computer network." A14-15 (referring to Schmandt Figures 1 and 5 and Stefanopoulos' Abstract). The Board also determined that the internet features, argued by TI, were simply not claimed. A15-16.

The Board addressed claims 5-19 and the arguments that TI made in its Appeal Brief concerning those claims. A17-18. In its analysis, the Board expressly referred to the examiner's findings (A51-55). The Board also determined that TI's argument concerning these claims simply failed to rebut these findings, noting that

TI had essentially just summarized its interpretation of the prior art, repeated the claims, drew general conclusions that the applied references do not suggest the claimed features, and set forth only “minimal arguments” for these claims. A17-18.

4. TI’s Request for Reconsideration

TI reasserted its position on speech user agent and computer network. A110-13, 120. In addition, for claim 1, TI argued that no reasonable expectation of success had been shown in the prior art for the combination. A113.

In seeking reconsideration for claims 11 and 14, TI additionally argued, over the course of five pages, certain claimed features. A115-19. At this point, TI discussed the last four limitations for claim 11 concerning a grammar and the use thereof. A115. None of these limitations was argued and explained by TI in its Board Appeal Brief. A84-86 (part of brief concerning claim 11).

5. Reconsideration Decision

The Board re-addressed TI’s Appeal Brief arguments concerning speech user agent and computer network. A2-3. The Board found that TI made several new arguments in its request for reconsideration. A2-6 (noting a new argument on each of these pages). In light of TI’s request, the Board maintained its obviousness conclusion in view of the claim language, and Stefanopoulos and Schmandt. A3-6.

D. TI's Appeal Brief to this Court

On appeal to this Court, TI has again advanced its arguments concerning speech user agent and computer network/internet which it presented in its Board Appeal Brief. Br. at 35-47. However, in addition, TI now makes arguments, concerning claim 11, which it did not make in its Board Appeal Brief. Br. at 19-31. This argument is extensive covering thirteen pages of its brief here and addresses numerous claim limitations. Br. at 19-31.

SUMMARY OF THE ARGUMENT

Stefanopoulos discloses all the elements of claim 1 except for one, a speech user agent. Schmandt discloses a speech user agent. Schmandt also discloses the motivation to use speech for computer manipulation instead of external, time-consuming items such as a computer mouse. The Board's findings are supported by the substantial evidence as found in Stefanopoulos and Schmandt. Additionally, the Board properly construed the disputed phrases "computer network" and "speech user agent," giving them their ordinary meaning. In addition, TI's specification and the doctrine of claim differentiation support the Board's claim construction.

As to claim 14, the next broadest independent claim, substantial evidence also supports the Board's findings that a skilled electronic speech artisan would have

been motivated to add to Stefanopoulos' browser a grammar producer specific to particular applications, as taught by Schmandt.

TI's new and ever-changing arguments, made over the course of its prosecution of this case, simply fail to show reversible error in the Board's decision with respect to claim 11. Accordingly, the other claims in the application should fall with independent claims 1 and 14.

ARGUMENT

A. Standard of Review

TI must show that the Board erred in its obviousness conclusion which is a question of law, or committed reversible error with respect to its underlying factual findings which are reviewed under the substantial evidence standard. In re Gartside, 203 F.3d 1305, 1315-16, 53 USPQ2d 1769, 1775-76 (Fed. Cir. 2000). "Substantial evidence is something less than the weight of the evidence but more than a mere scintilla of evidence," In re Kotzab, 217 F.3d 1365, 1369, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000), and "means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion," Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229 (1938).

What a prior art reference discloses is a question of fact. Para-Ordnance Mfg. v. SGS Importers Int'l, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1239 (Fed. Cir. 1995). Similarly, whether a person of ordinary skill would have been motivated to combine prior art disclosures is also a question of fact. Gartside, 203 F.3d at 1316, 53 USPQ2d at 1776.

During patent prosecution, claims are given their “broadest reasonable interpretation.” In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

B. Substantial evidence supports the Board’s determination that claim 1 would have been obvious to a person skilled in the electronic speech art

1. Stefanopoulos discloses each limitation of claim 1 except one – a speech user agent

Stefanopoulos discloses a database browser having a cursor and selection/highlighting option. A132, Figure 3g; A133, Figure 3i; A149, col. 5, lines 25-35. Thus, claim 1’s browser limitation (A159, line 4) is disclosed in Stefanopoulos. Stefanopoulos also discloses an information resource or “databases” 16 and 17 from which the browser selects. A126, col. 2, lines 4-10; A127, Figure 1, elements 17a, 17b, 18; A149, col. 5, lines 27-34, 51-55, col. 6, lines 32-42. Accordingly, Stefanopoulos discloses claim 1’s limitation of an information resource. A159, line 5.

Stefanopoulos also discloses that his browser system may “include selectable areas that provide access to additional linked expert systems.” A126, col. 2, lines 20-21 (emphasis added). This teaching thereby discloses claim 1’s limitation that the information resource be “located on a computer network.” A159, lines 5-6.³ Thus, Stefanopoulos discloses claim 1, except for a speech user agent.

2. Schmandt discloses a speech user agent

The Board and examiner found that Schmandt discloses a speech user agent, in view of the phrase’s ordinary meaning. A12-13. Schmandt supports this finding. The reference, in several places, specifically discloses “Xspeak,” which is an interface device where speech is the input and the corresponding output selects within a database, in view of the input. E.g., A152, col. 1, ¶ 2, col. 2, lines 1-11; A154, Figure 1, cols. 1-2; A157, Figure 5. Xspeak is the agent or device for the speech of a user, producing the desired response based on the user’s spoken command. Thus, Schmandt discloses the “speech user agent” recited in claim 1.

3. Schmandt discloses the motivation to use his speech user agent with Stefanopoulos’ browser

The motivation to substitute a feature found in the prior art into another prior art device may come directly from prior art references which teach that feature.

³ The Board found that Schmandt also discloses a computer network. A14-15 (referring to Schmandt Figures 1 and 5).

See In re Rouffet, 149 F.3d 1350, 1355-56, 47 USPQ2d 1453, 1456 (Fed. Cir.

1998). In this case, as the Board found, Schmandt itself provides motivation to use his disclosure of Xspeak with a system such as Stefanopoulos’.

Schmandt expressly teaches that by associating speech with a desired output or selection, using Xspeak, the speech user agent assumes “some of the functions currently assigned to the mouse . . . without [the user] removing his or her hands from the keyboard.” A152, col. 1, ¶ 2. Schmandt also states “[w]ith Xspeak, window navigation tasks usually performed with a mouse can be controlled by voice” (A152, col. 2, lines 1-5), and “allowing users to remain focused on the screen and keyboard, instead of fumbling for the mouse, would be beneficial in a workstation environment” (A153, col. 2, lines 4-8) (emphasis added). Reducing the use of a mouse by substituting voice is also taught by Stefanopoulos. A148, col. 4, lines 28-38 (skilled artisans may employ “voice-activated” devices to select outputs instead of a mouse).

Thus, contrary to TI’s argument (Br. at 41-47), Schmandt supplies the teaching which would motivate a skilled electronic speech artisan to use speech with a database browser. Schmandt expressly discloses the motivation for using speech over mechanical inputs, such as a mouse, that distract user’s attention from the screen and keyboard. See A152, col. 1, ¶ 2; A152, col. 2; A153, col. 2, lines 1-

8; A154, cols. 1-2. Thus, the evidence supporting the motivation finding comes from the prior art itself. See Rouffet, 149 F.3d at 1355-56, 47 USPQ2d at 1456.

4. The Board's construction of "computer network" and "speech user agent" was reasonable

TI argued to the Board that claim 1's limitation "computer network" was not found in the prior art because its invention concerned the internet. A84-86. In finding this limitation disclosed by both Stefanopoulos and Schmandt, the Board construed the phrase "computer network" as a computer connecting to a database or other computer system. A14-15.

This construction is reasonable because the ordinary meaning of these two words is that a computer or PC is used within an arrangement of electronic or computer devices. Moreover, TI's specification expressly supports the Board's construction by stating "within the scope of the claims . . . the voice activated system could be used with other systems (e.g. on-line documentation systems, databases, ..)." See Specification at A36, lines 4-6 (emphasis added). Accordingly, TI's specification fully supports the ordinary meaning for "computer network." See, e.g., Johnson Worldwide Assocs., Inc. v. Zebco Corp., 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999) (there is a "heavy presumption" that claim language has its ordinary meaning and the presumption is only overcome when the

specification states otherwise or claim scope cannot be determined due to the language). In view of the specification's language and the clarity of claim scope, neither of the exceptions to the "heavy presumption" for ordinary meaning exists in this case.

Dependent claim 5 also supports the Board's construction by stating that the information resource is "an HTML page." A159. As TI's specification makes clear, "HTML pages [are] delivered on the World Wide Web." A27, lines 13-14. Thus, independent claim 1's "computer network" is not limited to "an HTML page," the Internet, or the World Wide Web, as TI now suggests to this Court, in view of dependent claim 5. See Comark Comms., Inc. v. Harris Corp., 156 F.3d 1182, 1187, 48 USPQ2d 1001, 1005 (Fed. Cir. 1998) ("There is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims") (citation omitted); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1054-55, 5 USPQ2d 1434, 1441 (Fed. Cir. 1988) ("narrow claim limitations cannot be read into the broad [claims]"). Such a narrowing construction would improperly render claim 5 superfluous.

If TI wished to limit claim 1 more narrowly than the ordinary breadth of "computer network," it could have amended its claim. See Burlington Indus. v. Quigg, 822 F.2d 1581, 1583, 3 USPQ2d 1436, 1438 (Fed. Cir. 1987) ("claims are

given their broadest reasonable interpretation during examination proceedings, for the simple reason that before a patent is granted the claims are readily amended as part of the examination process”). The Board is required to interpret claim limitations as broadly as reasonable. See, e.g., Hyatt, 211 F.3d at 1372, 54 USPQ2d at 1667; In re Morris, 127 F.3d 1048, 1055, 44 USPQ2d 1023, 1028–29 (Fed. Cir. 1997). “This approach serves the public interest by reducing the possibility that claims, finally allowed, will be given broader scope than is justified.” In re Yamamoto, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984).

TI has also argued that “speech user agent” was misinterpreted by the Board. Br. at 35-37. However, the Board also reasonably construed this phrase by focusing on its ordinary meaning. A12-13. “Speech user agent” refers to a system where a user can employ speech or voice with the assistance of a representative, transformer or facilitator. See Johnson Worldwide, 175 F.3d at 989, 50 USPQ2d at 1610 (ordinary meaning of claim language generally governs). The specification is wholly consistent with such an interpretation. See A29, lines 6-7 (“The user then associates the start symbol ‘what_is_the_weather’ with the appropriate URL in a separate file”). Nowhere in TI’s specification has it expressly defined this phrase as something different than its ordinary meaning. Thus, speech user agent simply

means some type of representative for the speech or voice of the system's user, as determined by the Board, and as found in Schmandt.⁴

C. Claim 14 would also have been obvious to a skilled electronic speech artisan in view of Stefanopoulos and Schmandt

Independent claim 14 adds to claim 1 the capacity to produce a grammar for use in the system. A160.⁵ Schmandt discloses this limitation. Schmandt states that his "Xspeak II," an improved version of Xspeak, "includes a user interface specification language, a rich tool for adding voice input to applications." A152,

⁴ For the dependent claims, TI's short argument (Br. at 47-48) mistakenly asserts that the examiner did not rely on evidence. This is not the case since the examiner made findings (A51, line 18 - A55, line 11) by pointing to the following evidence for particular claims: for claim 6 "Stefanopoulos teaches . . . an instructional module for communicating allowed actions by a user [Fig. 4h, Col. 6, lines 55-68, Figs. 5a-5g, Col. 7, lines 19-23];" for claims 7 and 8 "Schmandt et al., teach a speech recognizer [page 50, paragraph 2];" for claim 10 "Schmandt teaches speech recognizer dependent actions [page 50, paragraph 2];" for claims 12 and 13 "Schmandt et al., teach tokenizing a title and dynamic addition of grammar to a speech recognizer [page 53, Col. last paragraph, Col. 3, first and second paragraphs];" for claims 15-18 "Schmandt et al., teach the means of recognizing and dynamic addition of grammar to a speech recognizer [page 53, Col. last paragraph, Col. 3, first and second paragraphs]." Thus, TI's assertions are misplaced.

Moreover, TI's general argument (Br. at 47-48) for the dependent claims does not advance them separately to this Court, and thus they should fall with independent claim 1. See In re Dance, 160 F.3d 1339, 1340 n.2, 48 USPQ2d 1635, 1636 n.2 (Fed. Cir. 1998).

⁵ TI has never argued, or pointed to, any specification structure for attempting to distinguish this means limitation from the prior art. See A63-64, 73-75, 83-87, 114-15, 119-23.

col. 3, lines 22-25 (emphasis added). Xspeak II has the ability to create language subtemplates to have context-dependent recognition which “improves recognition rates.” A156, col. 2, lines 6-9. A grammar is thereby produced to suit particular applications. Thus, Schmandt not only teaches the limitation, but motivation to use this “rich tool” with an information resource such as Stefanopoulos’ in order to have the benefit of reducing manual input and “improv[ing] recognition rates.” Accordingly, the motivation finding for combining Stefanopoulos and Schmandt to make the invention of claim 14 is also supported by substantial evidence.

TI has asserted that claim 14 concerns “accessing remote data across a network such as the internet.” A86, lines 10-12. However, the language of claim 14 is not even limited to a “computer network.” See A160 (limiting claim 14 to speech user agent, information resource or database, browser and grammar producer). As discussed above, a reference to the internet by “HTML page” appears only in claim 5. A159-60. By continually referring to the internet or web with respect to claims other than claim 5, TI is simply, and improperly, reading limitations into these other claims. See, e.g., Hyatt, 211 F.3d at 1372, 54 USPQ2d at 1667; Morris, 127 F.3d at 1055, 44 USPQ2d at 1028–29. TI’s position would inappropriately render claim 5 superfluous. Accordingly, TI’s arguments to the Board for claim 14 should be rejected.

D. The USPTO's decision that claim 11 is unpatentable should be affirmed

In its Appeal Brief to the Board, TI specifically argued and explained the speech user agent and network limitations, and the internet. A83-87. The Board thoroughly addressed these arguments (A12-16), and the Director has rebutted them above.

TI's brief to this Court includes a series of arguments concerning agency findings made during prosecution. However, most of the claim limitations which TI now addresses were not timely argued and explained during the administrative process. Thus, the Board was correct in not sua sponte addressing all the limitations in TI's patent application.

1. The Board was not required to address the claim 11 limitations not argued by TI in appealing to the Board

This Court requires lower tribunals to address arguments which are "raised with sufficient specificity and clarity that the tribunal is aware that it must decide the issue." Wallace v. Air Force, 879 F.2d 829, 832 (Fed. Cir. 1989). The Board's precise regulation on this point is highly instructive, and reads:

For each rejection under 35 U.S.C. 103, the argument shall specify the errors in the rejection and, if appropriate, the specific limitations in the rejected claims which are not described in the prior art relied on in the rejection, and shall explain how such limitations render the claimed subject matter unobvious over the prior art.

37 C.F.R. § 1.192(c)(8)(iv) (emphasis added). See also Hyatt, 211 F.3d at 1373,

54 USPQ2d at 1668 (arguments must be properly made to the Board in order to preserve them for appeal to the Court).

Thus, pursuant to the regulation, an appeal brief to the Board will be considered for the “specific limitations” explained by the applicant in the argument section of his appeal brief. In fact, this Court has virtually the same rule for appellate briefs. See Becton Dickinson & Co. v. C.R. Bard, Inc., 922 F.2d 792, 800, 17 USPQ2d 1097, 1103 (Fed. Cir. 1990) (“an issue not raised by an appellant in its opening brief . . . is waived”) (emphasis added).

The Board of Patent Appeals and Interferences hears appeals from an examiner’s rejection. 35 U.S.C. § 134. As an appellate tribunal, the Board addresses arguments made by the appealing applicant. That is, the Board does not address a patent application in its entirety as an examiner does when the application is initially filed with the USPTO. Considering the high volume of appeals to the Board, and the breadth of the individual applications involved, authorities such as Wallace, 37 C.F.R. § 1.192(c)(8)(iv), Hyatt, and Becton Dickinson make eminent sense. In fact, they are necessities. Accordingly, unless an appellant/applicant raises and explains an alleged error in the initial Board brief, as is required by the above regulation, the Board cannot rightly be faulted for not deciding an issue that was never raised, or making additional findings in connection therewith.

In its Appeal Brief to the Board, TI argued and explained, for claim 11, only the “computer network” and “speech user agent” limitations. See A83-87. Thus, TI at that point in time, considered it appropriate to argue and explain only these two limitations for claim 11 to the Board. The Board considered and rejected TI’s argument concerning the only two limitations which TI presented, fairly assuming that TI made no challenge as to the other limitations for claim 11. A12-15, 17-18. The Board then entered its final decision. A9.

2. In its request for reconsideration, TI made new arguments concerning claim 11 which were simply made too late in the administrative process

After the Board’s final decision, TI filed a request for reconsideration. In its reconsideration request, TI argued numerous limitations for claim 11 (A115-19), which limitations were not previously argued and explained by TI in its Board Appeal Brief (A83-87 (arguing speech user agent, computer network and internet)).

Contrary to TI’s timing, this Court has clearly held:

“A party cannot wait until after the Board has rendered an adverse decision and then present new arguments in a request for reconsideration.”

Cooper v. Goldfarb, 154 F.3d 1321, 1331, 47 USPQ2d 1896, 1904 (Fed. Cir.

1998); see also 37 C.F.R. § 1.197(b) (reconsideration request to the Board must center on what was “misapprehended or overlooked” at the time the Board was

rendering its decision). As the Supreme Court has instructed:

“Simple fairness to those who are engaged in the tasks of administration, and to litigants, requires as a general rule that courts should not topple over administrative decisions unless the administrative body not only has erred but has erred against objection made at the *time appropriate* under its practice.”

United States v. L.A. Tucker Truck Lines, 344 U.S. 33, 37 (1952) (emphasis added).

Thus, pursuant to Cooper and the other above authorities, arguments (e.g., arguing and explaining a particular claim limitation(s)) must be made in the appealing applicant’s brief to the Board, which is filed before the Board considers the case and enters a decision. The “time appropriate” for TI to have argued and explained numerous claim 11 limitations was when it filed its Board Appeal Brief, and not for the first time in its request for reconsideration. Any deviation from this rule of law would encourage applicants, in the numerous appeals to the Board each year, to argue one set of arguments in its Appeal Brief and then after the Board has provided substantial evidence, switch to a different set of arguments on reconsideration to the Board post-decision. The system surely cannot tolerate such a practice. Thus, the Board correctly declined to address the newly-argued

limitations for claim 11 in TI's later request for reconsideration. See A2-6 (noting a new argument on each of these pages).

3. Before this Court, TI has waived any arguments as to claim 11 other than those it made in its Board Appeal Brief

In a similar vein, the only limitations of claim 11 that TI preserved to argue to this Court are the speech user agent and computer network limitation arguments, fully addressed above. Any argument extending beyond those made in its Board Appeal Brief (A83-87) is improper and cannot show reversible error. The same policies underlying the prohibition against an applicant arguing and explaining new matters to the Board after its decision (i.e., in a reconsideration request) apply with even more force for new and later arguments made in briefs to this Court. See, e.g., In re Schreiber, 128 F.3d 1473, 1479, 44 USPQ2d 1429, 1433 (Fed. Cir. 1997) (argument that was not raised before the Board was declined to be considered for the first time on appeal); Sewall v. Walters, 21 F.3d 411, 418, 30 USPQ2d 1356, 1360 (Fed. Cir. 1994) ("Because this issue was not raised below, we do not decide it in this appeal"); Chester v. Miller, 906 F.2d 1574, 1578 n.6, 15 USPQ2d 1333, 1337 n.6 (Fed. Cir. 1990) ("This court will not consider arguments that were not timely raised before the Board"); Mead v. McKirnan, 585 F.2d 504, 508, 199 USPQ 513, 516 (CCPA 1978) ("Appellant's remaining arguments were not

raised before the PTO and hence are not properly presented here for the first time”); In re Fong, 378 F.2d 977, 981, 154 USPQ 25, 28-29 (CCPA 1967) (“When an examiner’s statement is first controverted on appeal to us, especially for lack of evidentiary support, we are not only deprived of the benefit of his views and those of the board on the particular point, but we also lack assurance that the appropriate support could not have been provided, absent the implicit acceptance of the statement’s validity by appellants below”).

This Court has also applied a similar rule to patent cases proceeding in another agency, the U.S. International Trade Commission. In an intra-agency appeal of an Administrative Law Judge’s determination to the full Commission (similar to appealing from an examiner’s rejection to the Board), specific arguments made in this Court must have been properly preserved below by being made in the brief to the Commission. See, e.g., Checkpoint Systems, Inc. v. U.S. Int’l Trade Comm’n, 54 F.3d 756, 760, 35 USPQ2d 1042, 1046 (Fed. Cir. 1995) (“Checkpoint may not raise its claim interpretation issue for the first time in its appeal to this court, and we will not consider that portion of Checkpoint's appeal”); Texas Instruments, Inc. v. U.S. Int’l Trade Comm’n, 988 F.2d 1165, 1176, 26 USPQ2d 1018, 1027 (Fed.Cir.1993) (“This court will not review an issue that has not been properly raised before the ITC in a petition for review of an Initial Determination”).

Accordingly, arguments other than those which TI specifically made on appeal to the Board in its Appeal Brief should not be considered now, at the next level of review. They are simply too late. TI's timely arguments (computer network, speech user agent) were fully addressed by the Board and are addressed in this brief.

CONCLUSION

Since TI's electronic speech browser would have been obvious to a skilled electronic speech artisan in view of Stefanopoulos' browser and Schmandt's speech recognition teachings, this Court should affirm the Board's decision.

Respectfully submitted,



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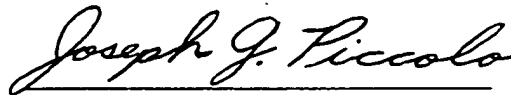
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October 22, 2001

CERTIFICATE OF SERVICE

I hereby certify that on October 22, 2001, I caused two copies of the foregoing BRIEF FOR APPELLEE DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE to be transmitted by U.S. Express Mail to:

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